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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

92/D03-008A

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on July 13, 2006

Signature

Typed or printed name Keith R. Jarosik

Application Number

10/667,259

Filed

09/19/2003

First Named Inventor

Dondlinger

Art Unit

3634

Examiner

Jerry E. Redman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 47,683

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 47,683

Signature

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Typed or printed name

312-580-1020

Telephone number

July 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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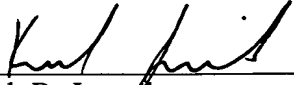
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	: DONDLINGER et al.)	I hereby certify that this paper (and/or fee)
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U.S. Serial No.	: 10/667,259)	Postal Service as first class mail in an
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Filed	: September 19, 2003)	
)	Mail Stop AF
Title	: Inflatable Door Seal)	Commissioner for Patents
)	P.O. Box 1450
)	Alexandria, VA 22313-1450
)	
Art Unit	: 3634)	on this date: July 13, 2006
)	
Examiner	: Jerry E. Redman)	
)	
)	
)	Keith R. Jarosik
)	Registration No. 47,683

TRANSMISSION ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

A pre-appeal review of the above-referenced application is requested for at least the reasons stated below.

The Examiner Has Failed To Establish a *Prima Facie* Case of Obviousness

Claims 3, 6-9, 11-16, 34-36, 38, 40, 41, 43, 44, 46, 48, and 49 were rejected as unpatentable over Ganzinotti (USPN 3,341,974) in view of Long (USPN 6,098,992).

However, neither Ganzinotti nor Long, either or alone or in combination, discloses or suggests thermal insulation disposed inside at least a portion of an elongated air passageway.

Claims 2, 4, 5, 10, 37, 39, 45, and 47 are dependent claims that were rejected as unpatentable over Ganzinotti in view of Long and further in view of Knap. Knap does nothing to cure the deficiencies of the combination of Ganzinotti and Long, and the examiner does not suggest as much. Therefore, it is respectfully submitted that all claims are allowable over the combination of Ganzinotti, Long, and Knap for the reasons set forth below.

Neither Ganzinotti nor Long Discloses a Seal with Thermal Insulation

Independent claims 15, 40, and 48 are generally directed to a door having an insulated inflatable seal. Specifically, the claims recite, *inter alia*, a door having an inflatable seal between a door member and a door panel, wherein the inflatable seal defines an air inlet, an air outlet, and an elongated air passageway between the inlet and outlet. The claims further specify that the inflatable seal includes thermal insulation disposed inside at least a portion of the elongated passageway.

Ganzinotti fails to teach a seal with thermal insulation, a deficiency that the examiner acknowledges (see Office action of March 14, 2006, page 3). The examiner attempts to cure this deficiency by alleging that Long discloses “a heated inflatable seal having thermal insulation” and suggesting that it would have been obvious to one of ordinary skill to provide the seal of Ganzinotti with thermal insulation as taught by Long (*id.*). The examiner further alleges that Long discloses “‘a portion of thermal insulation’ contained within an inflatable seal” (Office action of March 14, 2006, page 4).

Contrary to the examiner’s assertions, though, Long does not teach or suggest thermal insulation disposed inside at least a portion of the passageway of an inflatable seal. Rather, Long teaches a collapsible seal attached to a vacuum source including a heating element (57) disposed on a reflective shield (56) and connected to an electrical wire (58). (See col. 5, lines 3-15, and Fig. 5). These three elements are conductors of thermal energy, not thermal insulation, as is claimed here. Furthermore, the only disclosure regarding insulators in Long pertains to the point of attachment of the seal members to the surrounding structure, but these insulators are electrical (*e.g.*, “connector or clip 102’ is electrically insulated as indicated at 114,” col. 7, ll. 47-48), as opposed to thermal insulators. Thus, contrary to the allegations in the Office action, Long fails to teach or suggest thermal insulation disposed within at least a portion of the elongated passageway of an inflatable seal.

Accordingly, neither Ganzinotti nor Long discloses thermal insulation disposed within at least a portion of an inflatable seal. Because neither reference discloses this claimed element, no combination of the two references can result in the claimed system. The examiner alleges that the applicant argues the references individually and not the combination thereof, but the MPEP clearly states that “the prior art reference (or references when combined) must teach or suggest all the claim limitations” in order to establish a *prima facie* case of obviousness. MPEP § 2142. The applicant respectfully submits that because neither Ganzinotti nor Long (individually) teaches or suggests thermal insulation disposed within at least a portion of an inflatable seal, the combination of the references cannot teach a system with the missing element. Thus, the prior art references do not teach or suggest all the claim limitations as is required to establish a *prima facie* case of obviousness under MPEP § 2142. Accordingly, it is respectfully submitted that claims 15, 40, and 48 and all claims dependent thereon are in condition for allowance.

There is No Motivation to Combine the Cited References

It is well established that the mere fact that references can be combined is not sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (emphasis original).

In order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not ‘evidence.’** (emphasis added, citations omitted).

The suggestion to combine references must be from the prior art, not Applicants’ disclosure. See Section 2143 of the M.P.E.P., which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

The rejections of the claims are based on the allegation that one of ordinary skill in the art at the time of the invention would seek to provide the seal of Ganzinotti with thermal insulation as taught by Long, since thermal insulation provides less heat transfer and thereby increases the efficiency of the system. (Office action, p. 4-5).

However, the combination proposed in the Office action is predicated on Long actually teaching thermal insulation (which it does not), and that one of ordinary skill in the art of inflatable seals would look to collapsible seals or that one of ordinary skill in the art would blindly look to increase thermal efficiency, without regard to any drawbacks associated therewith.

Specifically, as noted above, Long does not teach or suggest thermal insulation, but rather, teaches a heating element within the seal. Moreover, Ganzinatti specifically rejects heating elements of the type described in Long stating that “formation of frost is often prevented by arranging an electrical heating resistance element near the joint. Whilst being quite satisfactory, this solution is costly and it does not generally allow the joint to be uniformly reheated.” (Col. 1, line 30).

Also, as overlooked by the examiner, the operating principles associated with collapsible seals is significantly different than those of inflatable seals. For example, Long

teaches the use of a vacuum to collapse a seal in order to prevent frost. This action entails breaking contact between the seal and the contact surface. In contrast Ganzinotti teaches the circulation of air in an inflatable system, designed to maintain seal contact. Additionally one would necessarily look to combine Ganzinotti with the teachings of Long because to do so would add thickness and/or rigidity to the inflatable seal which may have unintended and detrimental impact on the inflatable seal efficiency. Accordingly, despite the assertions by the examiner, there is no evidence that one of ordinary skill in the art would have been motivated to look to the collapsible seal of Long to modify the teachings of Ganzinotti for any reason.


Therefore, because there is no suggestion in the prior art for the desirability to combine the references, it is respectfully submitted that a *prima facie* case of obviousness, has not been established. Thus, for at least these reasons, the claims are in condition for allowance.

Conclusion

Because the examiner has failed to establish a *prima facie* case of obviousness, reconsideration of the application and allowance thereof are respectfully requested.

Respectfully submitted,
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